

8. The method as set forth in claim 7 including the additional step of simultaneously applying an elevated pressure within the patient's airway.

9. the method as set forth in claim 8 wherein said elevated pressure is of a magnitude greater than ambient atmospheric pressure.

REMARKS

Applicant respectfully requests entry of the above amendments in the accompanying continuation application prior to any action on the merits.

These amendments are intended to conform the accompanying continuation application to prior copending reissue application Serial No. 08/702,107 as currently pending, and in addition to incorporate the unentered Amendment under Rule 116 which was filed in the identified prior copending application on October 8, 1999.

In order to comply with various requirements for reissue application amendments stated at MPEP 1453, applicant notes the following:

- The status of all claims is as follows. Claims 1-9 are pending
- The above amendments add claims 4-9, which claim the invention without reference to pressure less than ambient as a preferred impetus for distending frontal portions of a patient's neck.
- Support for claims 4-9 is found in the patent specification at, inter alia, Col. 6, Lines 34-40, and Col. 9, Lines 17-20 and 28-36.

Applicant notes that in the identified parent application the question of correct inventor identification has been addressed and resolved, but the amendment is presented again here as the accompanying continuation application is not being filed under any "continuing prosecution" procedure. For this and all other aspects of reissue application prosecution, excepting only prosecution of added claims 4-9, applicant relies on and hereby incorporates by reference the prosecution history of parent application Serial No. 08/802,107.

The above claim amendments address the rejection under 35 USC 112 of record in the parent application, in which examiner held the recital of an "impetus" is new matter. The above claims 4-9 overcome the Section 112 rejection by reciting the novel method in terms of distending action applied to frontal portions of a patient's neck, without reference to an impetus. The claims thus are more consistent with the disclosure of the original specification. Claims 4-9 also are believed to distinguish patentably over all art of record.

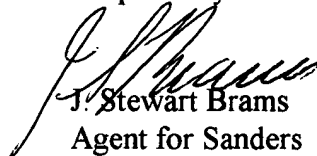
Applicant has previously traversed the new matter rejection in the parent application. Substitution of "impetus" for the original "pressure sufficiently less than ambient pressure to distend..." is not new matter. Surely examiner will concur that the claims as now presented find support in the original specification and contain no new matter. The specification clearly discloses the action of distending frontal portions of a patient's neck. Yet examiner is also of record as holding, with respect to the unamended version of the same claims, as originally presented in the parent application, that the "specification, as originally filed, does not provide support for the breadth of the invention as is now claimed" (parent application, office action 6/18/97). How can it be that the

claims reciting an "impetus" (rather than a pressure as in the issued patent claims) find no support in the specification, while the broader amended claims presented above, which recite neither impetus nor pressure, are supported by the specification?

The answer is that the narrower claims reciting an impetus indeed are supported by the specification, because a disclosure of method in terms of action steps always implicitly includes an impetus to drive the disclosed action. Even though an impetus is not recited in newly presented claims 4-9, the argument is not moot. The point to be made is that the patentable method requires no impetus limitation at all, whether a general or a specific one, because the patentable method is the action, not the impetus that drives the action. This is commonplace in claim construction. Patentable method claims routinely recite action steps without reference to the impetus that drives the action. Applicant thus submits that claims 4-9, either with or without recital of an impetus, include no new matter and are fully supported by the original specification .

Applicant respectfully requests entry of the above amendments prior to any action on the merits, consideration of the above remarks, and notice of allowance as to all pending claims.

Respectfully submitted,


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